

REMARKS

I. INTRODUCTORY COMMENTS

The Applicant thanks Examiner Huynh for his careful consideration of the instant application and for the indication of allowable subject matter in claims 7 and 8. Claims 1-5, 7-12, and 16-26 are pending in the application. By this Amendment, claims 1, 2, 4, 5, 11, 16-18, and 20 are amended to more particularly recite the features of the device for processing filter tow material for the production of filters for rod-shaped smoking articles. Claim 7 is rewritten in independent form and, therefore, is believed to be allowable. Claims 6 and 13-15 were previously canceled without prejudice or disclaimer. New claims 25 and 26 are added. In view of the foregoing amendments and following remarks, Applicant respectfully submits that the application is in condition for allowance and requests a notice stating the same. Reconsideration and withdrawal of the rejections are respectfully requested.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In numbered paragraph 2 on page 2 of the Final Office Action dated January 29, 2010, claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Final Office Action references several recited features lacking antecedent basis. In response, claim 4 is hereby amended to depend from claim 3 and to recite “a direction of the tow guideways”. These amendments are believed to provide the necessary antecedent basis. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

III. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

In numbered paragraph 4 on pages 2-5 of the Final Office Action, claims 1-5 and 16-21 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,460,590 to Greiner *et al.* (Greiner). The rejection is respectfully traversed. Nevertheless, in the interests of expediting prosecution, claims 1, 2, 4, 5, 16-18, and 20 are hereby amended to more particularly recite the features of the device for processing filter tow material for the production of filters for rod-shaped smoking articles. Reconsideration and withdrawal of the rejection are respectfully requested.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); *see* M.P.E.P § 2131. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

A. Claims 1-5 and 19

Amended claim 1 recites:

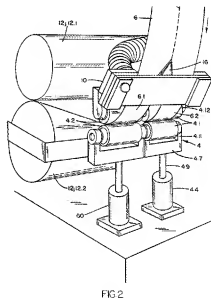
A device for processing filter tow material for the production of filters for rod-shaped smoking articles, said device comprising:
a filter tow supply configured to supply at least two filter tow strips;
at least two tow guideways, wherein each of the at least two filter tow strips is separately guided in a respective one of the at least two tow guideways; and
***a separately controlled processing apparatus assigned to each tow guideway for processing the respective filter tow strip, wherein each processing apparatus comprises:
first and second drawing roller pairs, wherein the first drawing roller pair in one of the at least two tow guideways is arranged coaxial and side-by-side in a single unit with the first drawing roller pair in the other of the at least two tow guideways to define first inner and outer drawing roller pairs, and wherein the second drawing roller pair in one of the at least two tow guideways is arranged coaxial and side-by-side in a single unit with the second drawing roller pair in the other of the at least two tow guideways to define second inner and outer drawing roller pairs, and wherein the first and second inner and outer drawing roller pairs are positioned and supported on only one side.***

(emphasis added). Claim 1 is amended to more particular recite the features of the separately controlled processing apparatuses assigned to the respective tow guideways including, *inter alia*, the recited arrangement of respective first and second drawing roller pairs along each tow guideway. Support for the added recitations in claim can be found, for example, in numbered paragraphs [00033] – [00034] of the substitute specification. *See also* FIGS. 1-4 (including elements 28, 29 and 30, 31). Claim 1, as amended, is not anticipated by Greiner for at least the following 3 reasons.

First, it is respectfully submitted that Greiner fails to teach or suggest the recited separately controlled processing apparatuses, each having first and second drawing roller pairs in each tow guideway and each drawing roller pair being arranged coaxial and side-by-side in a single unit with a corresponding drawing roller pair in the other tow guideway to define first and second inner and outer drawing roller pairs. The Final Office Action aligns Greiner's brake roll pairs 4.1, 4.2 with the previously recited roller pairs. Importantly, however, Greiner recites that "[t]reatment unit 1 comprises a brake system 4, a driven stretch roll pair 12, a second driven stretch roll pair 11" (Greiner, col. 6, ll. 42-43) and that "the two brake roll pairs 4.1 and 4.2 are 'coupled', i.e. their correlated setting units are pressurized with the same compressed air . . . in order that the same brake force acts on the filter tow strips at both brake roll pairs 4.1 and 4.2" (Greiner, col. 6, ll. 58-64). In this regard, elements 4.1 and 4.2 are not separately controlled relative to one another as recited in claim 1.

Second, Greiner's stretch roll pairs 11, 12 are common to both filter tow strips 6.1, 6.2 and, therefore, are not part of separately controlled processing apparatuses assigned to each tow guideway as recited in at least claim 1. With reference to FIGS. 2 and 3, Greiner purportedly discloses that:

[A]fter the parting device 16, the single-width filter tow strips 6.1 and 6.2 pass through the brake roll pairs 4.1 and 4.2, in order to reach the stretch roll pair 12. After passing the stretch roll pair 12, the two single-width filter tow strips 6.1 and 6.2 get to the second stretch roll pair 11 of treatment unit 1, the two filter tow strips being stretched between the two stretch roll pairs 12 and 11, this being brought about by the setting of a differential speed between the driven stretch roll pairs. (Greiner, col. 7, ll. 8-15)



Thus, Greiner's first and second stretch roll pairs 12, 11 commonly serve to stretch both single-width filter tow strips 6.1, 6.2 and do not allow separate control and adjustment of the characteristics of the two filter tow strips to produce filter rods with different characteristics. The

separately controlled processing apparatuses in claim 1, however, allow as much. *See, e.g.*, paragraph [00036] of the instant specification.

Third, Greiner's brake roll pairs 4.1, 4.2 do not define first and second inner and outer drawing roller pairs positioned and supported on only one side as recited in amended claim 1. On the contrary, Greiner describes and shows "U-shaped support part 4.7 . . . in which is mounted a correlated brake roll 4.11 of the brake roll pair 4.1." Col. 6, ll. 51-52. That is, U-shaped support part 4.7 supports brake roll 4.11 at both ends thereof and not on *only* one side.

Accordingly, amended claim 1 is believed to be allowable over Greiner. Claims 2-5 and 19 depend variously from claim 1 and are believed to be allowable for at least the same reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Claims 16, 17, and 18

By this Amendment, claims 16 and 17 are amended to depend from claim 1. Claim 18 depends from claim 17. Accordingly, claims 16-18 are believed to be allowable for at least the same reasons set forth above with respect to claim 1. Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 16 is also substantively amended to recite "a separate removal device provided at an end of each tow guideway to separately transfer the filter tow strips, wherein each removal device comprises a pusher drum or a transfer spider." Support for the same can be found, for example, in numbered paragraph [00052] of the disclosure. Greiner fails to teach or suggest separate removal devices for each tow guideway to transfer the respective filter tow strips.

C. Claims 20 and 21

With regard to claim 20, the Final Office Action states that Greiner discloses "a shaping device including dual intake funnels (19) which comprises deflection means for deflecting each filter tow strips [sic]" Final Office Action, page 5. Importantly, however, amended claim 20 recites, in relevant part:

a shaping device for reshaping the filter tow strips into round filter tow rods; and

deflection means ***provided downstream of the shaping device***
for deflecting the round filter tow rods to reduce a center spacing
between the round filter tow rods.

(emphasis added). Thus, the shaping device and deflection means are separate elements, the latter disposed downstream of the former. The Final Office Action fails to cite separate corresponding elements for the shaping device and deflection means. That is, Greiner's dual intake funnels 19 cannot be both. Moreover, claim 20 is amended to recite that the deflection means are "provided downstream of the shaping device for deflecting the round filter tow rods to reduce a center spacing between the round filter tow rods." Greiner fails to teach or suggest any structure that deflects round filter tow rods to reduce a center spacing between the round filter tow rods. Accordingly, claim 20 is believed to be allowable. Claim 21 depends from claim 20 and is believed to be allowable for at least the same reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

A. Claims 9-12

In numbered paragraph 6 on pages 5-7 of the Final Office Action, claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greiner in view of U.S. Patent No. 7,261,681 to Pehmöller *et al.* ("Pehmöller"). The rejection is respectfully traversed. Reconsideration and withdrawal of the rejection are respectfully requested for at least the following reasons.

Pehmöller issued from an application filed in the United States on August 15, 2003, and can therefore only be eligible as prior art under 35 U.S.C. § 102(e). While Pehmöller has a different inventive entity than the instant application, Pehmöller and the instant application are commonly assigned to Hauni Maschinenbau AG. Pursuant to 35 U.S.C. § 103(c), the Applicant respectfully states that:

The instant application and U.S. Patent No. 7,261,681 to Pehmöller *et al.* were, at the time the instant invention was made, owned by, or subject to an obligation of assignment to, Hauni Maschinenbau AG.

Accordingly, Pehmöller is believed to be disqualified as "prior art" under 35 U.S.C. § 103(c). Reconsideration and withdrawal of the rejection are respectfully requested.

Furthermore, claim 9 recites, *inter alia*, that “the means for treating comprises a spray box arrangement that extends across the tow guideways, wherein the spray box arrangement comprises discharge openings in a wall facing the tow guideways, which discharge openings are assigned to the tow guideways for dispensing treatment fluid onto the filter tow strips, and wherein ***a first separating wall is arranged within the spray box arrangement between the tow guideways and a second separating wall is arranged between the tow guideways on the wall facing the tow guideways.***” (emphasis added). As acknowledged in the Final Office Action, Greiner fails to teach or suggest a spray box arrangement including the recited first and second separating walls. The Final Office Action nevertheless fails to provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” for modifying Greiner’s spray box 14 accordingly. *See In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), cited with approval in *KSR Int’l v. Teleflex, Inc.*, 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (2007). That is, the Examiner’s conclusory statement that “it would have been obvious to a skilled person in the art, at the time of [sic] the invention was made, as a matter of engineering design choice . . .” does not present a prima facie case of obviousness, particularly now that Pehmöller is disqualified as prior art.

Accordingly, claim 9 is believed to be allowable over Greiner. Claims 10-12 depend variously from claim 9 and are believed to be allowable for at least the same reasons. Reconsideration and withdrawal of the rejection are respectfully requested.

B. Claim 22

In numbered paragraph 7 on page 7 of the Final Office Action, claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greiner. The rejection is respectfully traversed. Greiner gives no suggestion that the dual intake funnels 19 are “attached to a joint holder, suspended from a parallelogram frame, which can essentially be pivoted in the direction of the filter tow rods” as recited in claim 22 nor does the Final Office Action provide “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” for modifying Greiner’s dual intake funnels accordingly. *See In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), cited with approval in *KSR Int’l v. Teleflex, Inc.*, 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (2007). In any event, claim 22 depends variously from claim 20 and is believed to be allowable for

at least the same reasons set forth above. Reconsideration and withdrawal of the rejection are respectfully requested.

C. Claims 23-24

In numbered paragraph 8 on pages 7-8 of the Final Office Action, claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greiner in view of Applicant Admitted Prior Art ("AAPA"). The rejection is respectfully traversed. Nowhere in the specification or during prosecution of the instant application does Applicant identify or label any recited subject matter as "prior art." Page 8 of the Final Office Action cites numbered paragraph [00037] of the instant application as purportedly containing an admission regarding what is "prior art." The Applicant respectfully disagrees with this assertion. A close review of paragraph [00037], which clearly relates to the inventive embodiments depicted in FIGS. 1-3, fails to indicate any hint of such an admission. In fact, the words "prior art" do not appear in this paragraph, or anywhere else in the specification for that matter. The Examiner has apparently placed unreasonable and unwarranted weight on use of the phrase "[i]n general" here and, as a result, has improperly interpreted the subsequent text as admitted prior art. Neither the law nor the facts support this conclusion. Accordingly, claims 23 and 24 are believed to be allowable over Greiner. Reconsideration and withdrawal of the rejection are respectfully requested.

V. NEW CLAIMS 25 AND 26

By this Amendment new claims 25 and 26 are added. Claim 25 depends from claim 1 and recites that "the first and second inner and outer drawing roller pairs are supported on a vertical back wall of a machine frame." Support for this recitation can be found, for example, numbered paragraph [00034] of the instant specification and FIGS. 2-3. Claim 25 depends from claim 1 and is believed to be allowable over Greiner for at least the same reasons set forth above.

Claim 26 depends from claim 3 and recites that "each means for flattening comprises first spreader nozzle and a second spreader nozzle constructed to flatten the respective filter tow strip." Support for this recitation can be found, for example, numbered paragraphs [00031] – [00032] of the instant specification and in FIGS. 1-2. Claim 26 further recites that "the means for treating comprises a spray box arrangement that extends across the tow guideways, the spray box including

first and second adjacent, slot-shaped openings assigned, respectively, to the first and second tow guideways.” Support for this recitation can be found, for example, numbered paragraph [00040] of the instant specification and in FIGS. 1, 3, and 5. Claim 26 depends variously from claim 1 and is believed to be allowable over Greiner for at least the same reasons set forth above.

Entry and consideration on the merits are respectfully requested.

VI. CONCLUSION

Claims 1-5, 7-12, and 16-26 are pending in the application. All of the stated grounds of objection and rejection are believed to have been properly overcome, traversed, or rendered moot. The Applicant respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. The Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. An early notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that a personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration on the merits is respectfully requested.

Dated: April 29, 2010

Respectfully submitted,

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